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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/266,674	03/11/1999	DEREK JONATHAN HARPER	P-8609	6125

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EXAMINER

SIRMONS, KEVIN C

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/266,674

Applicant(s)

HARPER ET AL.

Examiner

Kevin C. Sirmons

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-13, 16-22, 24-31, 33-37, 39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17, 18, 35-37, 39 and 40 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, 16, 19-22, 24-31, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-13, 16, 19-22, 24-31 and 33-34 are rejected under 35

U.S.C. 103(a) as being unpatentable over Krueger et al in view of Kashmer et al U.S. Pat. No. 4,465,485.

Krueger discloses a drip chamber system for draining cerebral spinal fluid from a brain comprising: a fluid tube (55); an outlet manifold (73) in fluid communication with the fluid tube, the outlet manifold having an outlet (distal end of 73); an inlet manifold in fluid communication with the fluid tube (59), the inlet manifold having an inlet and an outer surface (fig. 25), the inlet manifold having a vent (66), the inlet manifold having an inside surface (fig. 25); drainage bag (81) and stopcock (76). Krueger does not clearly disclose a filter made of a porous material wherein the pore size of the filter ranges from greater than .45 μm to about 5.0 μm and a vent that has a surface area ranging from about 0.8 cm^2 to about 5.0 cm^2 . Kashmer discloses a filter made of a porous material wherein the pore size of the filter ranges from greater than .45 μm to about .5 μm . Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the filter of Krueger with the filter as disclosed by

Kashmer to entrap and prevent microorganisms which may be found in a hospital environment from contaminating the drip/drainage bag/chamber (col. 6, lines 41-50).

Further, it would have been an obvious matter of design choice to design a filter with a specific pore size of the filter greater than .45 μm to about 5.0 μm , since applicant has not disclosed that the aforementioned specification solves any stated problem in the art, provides an advantage or is for any particular purpose and it appears that the invention would perform equally well with a filter with a pore size range from .22 μm to 5.0 μm . The aforementioned ranges are taken directly from applicant's specification. As to claim 37, (Kashmer discloses a hydrophobic vent having a hydrophobic porous material (40); see above rejections).

Additionally, it would have been an obvious matter of design choice to one of ordinary skill in the art at the time the invention was made to vary the dimensions of the surface area of a vent ranging from about 0.8 cm^2 to about 5.0 cm^2 , since applicant has not disclosed that the aforementioned specification solves any stated problem in the art, provides an advantage or is for any particular purpose and it appears that the invention would perform equally well with the surface area of vent as disclosed by Krueger.

As to claims 3 and 4, (see Kashmer (40)); as to claim 6-8, (66); as to claim 9-13, (fig. 7); as to claim 16, (see above rejections); as to claims 19-22, 24-31 and 33-34, (see above rejections)

Allowable Subject Matter

Claims 17, 18, 35-37, 39 and 40 are allowable over the prior art of record.

Response to Arguments

Applicant's arguments filed 3/21/05 have been fully considered but they are not persuasive.

The examiner has carefully reviewed and considered applicant's arguments in reference to the fact that neither Krueger nor Kashmer discloses or suggests a vent having a surface area ranging from about 0.8 cm² to about 5.0 cm².

The Applicant appears to have a misunderstanding of the legal requirements of an obviousness analysis under 36 U.S.C. 103. If the prior art lacks some suggestion of the surface area dimensions recited in the claims that does not equate to the claims **being** allowable.

Applicant's arguments are not persuasive because applicant stated that the relative sizes of the pores and the surface areas are **important variables** relevant to the creation of adequate venting for the drip chamber. It is the examiner's position that every filter and surface area with relative sizes is an important variable to the creation of adequate venting. However, applicant's specification does not exclude whether or not the surfaces areas could be variables sizes that are larger or smaller than the sizes claimed and in the specification. Additionally, applicant failed to indicate why these specific variables are ***critical*** to the success of the invention. Moreover, applicant failed to specifically point out how the surface area of a vent solves any stated problem in the

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art, provides an advantage or is for any particular purpose. Most importantly, it is the examiner's position that the invention would perform equally well with the surface area of Kruger.

Finally, the Examiner has clearly established a prima facie case of obviousness by indicating that, the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claims device was not patentably distinct from the prior art device. In *Gardner v. TEC Systems, Inc.* 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984)

The rejection has been maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin C. Sirmons whose telephone number is 571-272-4965. The examiner can normally be reached on Monday-Friday 6:30-4:00 ALT FRI.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin C. Sirmons
Primary Examiner
Art Unit 3763

Kevin C. Sirmons
6/7/05